

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MONTEREY RESEARCH, LLC,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 19-2083-NIQA-LAS
)	
QUALCOMM INCORPORATED,)	
QUALCOMM TECHNOLOGIES, INC., and)	
QUALCOMM CDMA TECHNOLOGIES)	
ASIA-PACIFIC PTE LTD.,)	
)	
Defendants.)	

DEFENDANTS' NOTICE OF *INTER PARTES* REVIEW INSTITUTION DECISIONS

Defendants Qualcomm Incorporated, Qualcomm Technologies, Inc., and Qualcomm CDMA Technologies Asia-Pacific PTE LTD (“Qualcomm”) filed a Motion to Stay Pending *Inter Partes* Review (“IPR”) and accompanying brief in support on February 18, 2021. (D.I. 70, 71). Qualcomm respectfully notifies the Court that the Patent Trial and Appeal Board (“PTAB”) of the United States Patent and Trademark Office has instituted review of three patents asserted by Plaintiff Monterey Research, LLC (“Monterey”) against Qualcomm in the above-captioned action:

- U.S. Patent No. 6,534,805 (the “’805 Patent”). *See* Ex. A.
- U.S. Patent No. 6,651,134 (the “’134 Patent”). *See* Ex. B.
- U.S. Patent No. 6,765,407 (the “’407 Patent”). *See* Ex. C.

In its institution decisions, the PTAB determined that Qualcomm has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of each patent, and has thus instituted review for all claims challenged by Qualcomm’s petitions. *See* Ex. A at 2; Ex. B at 2; Ex. C at 2. The PTAB has scheduled Oral Arguments on

December 7, 2021, and is required by statute, 35 U.S.C. § 316(a)(11), to issue Final Decisions in these IPRs by no later than March 8, 2022.

The instituted IPR proceedings encompass all claims of the '805, '134, and '407 Patents asserted against Qualcomm in this case. In addition, Qualcomm's IPR petitions for the five remaining patents asserted against Qualcomm are also pending. These IPR proceedings are summarized in the table below:

Patent	IPR No.	Institution Status	Asserted Claims Covered
6,459,625	2021-00130	Pending (decision expected by 6/17/21)	All asserted claims (Claim 10)
6,534,805	2020-01491	Instituted	All asserted claims (Claims 8, 12, 14, 16, 18, 20, 22-25, 27-28, 30, 53-57, and 59)
6,642,573	2021-00125	Pending (decision expected by 6/3/21)	All asserted claims (Claims 1, 9-11, and 20)
6,651,134	2020-01492	Instituted	All asserted claims (Claims 1-5, 9, 13, 14, and 16-18)
6,680,516	2021-00119	Pending (decision expected by 5/18/21)	All asserted claims (Claims 5, 7, and 11)
6,765,407	2020-01493	Instituted	All asserted claims (Claims 1, 3, 7-8, 10, and 14-15)
7,572,727	2021-00120	Pending (decision expected by 5/18/21)	All asserted claims (Claims 1 and 6)
7,977,797	2021-00121	Pending (decision expected 5/19/21)	All asserted claims (Claims 1-7)

Qualcomm will apprise the Court of any institution decisions issued in these pending IPR petitions and any other relevant developments in the instituted IPR proceedings.

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